

REMARKS

The application includes claims 1-22 and 77-100 prior to entering this amendment.

The examiner rejects claims 1-19, 77-86, and 90-97 under 35 U.S.C. § 102(e) as being anticipated by Black, et al. (U.S. Patent No. 6,754,833).

The examiner rejects claims 20-22, 87-89, and 98-100 under 35 U.S.C. § 103(a) as being unpatentable over Black in view of Zhang, et al. (U.S. Patent Application No. 2005/0044216).

The applicants amend claims 1-2, 4, 6, 8, 11-12, 19-22, 77-100 to more clearly point out and distinctly claim the applicants patentable techniques, and not for any other reason.

The applicants cancel claims 13-18, and add new claims 101-106, maintaining the number of finally rejected claims.

The application remains with claims 1-12, 19-22 and 77-106 after entering this amendment.

The applicants add no new matter and request reconsideration in view of the following remarks.

The applicants point out that the claimed subject matter may be patentably distinguished from the cited reference(s) for multiple reasons; however, the following remarks are believed to be sufficient. Likewise, the applicants note that their failure to comment directly upon any of the positions asserted by the examiner in the office action does not indicate agreement or acquiescence with those asserted positions.

Claim Amendments

The applicants amend claims 1-2, 4, 6, 8, 11-12, 19-22, and 77-100, cancel claims 13-18, and add new claims 101-106. Support for the amendments and new claims may be found in the application as filed, for example, on pages 4, 9-11, and 13-15.

Claim Objections

The applicants thank the examiner for pointing out the informality in claim numbering. The applicants have corrected the claim numbering according to the examiner's suggestions.

Withdrawal of Final Rejection

The applicants request that the examiner withdraw the finality of this rejection. The applicants remind that examiner that:

“The examiner may withdraw the rejection of finally rejected claims. If new facts or reasons are presented such as to convince the examiner that the previously rejected claims are in fact allowable or patentable in the case of reexamination, then the final rejection should be withdrawn. Occasionally, the finality of a rejection may be withdrawn in order to apply a new ground of rejection.”¹

As we describe in further detail below, the examiner should withdraw the rejection of independent claims 1, 77, and 90 for the following reasons:

- Rejections under 35 USC 102(e) are valid only if each and every element is expressly or inherently described in a single prior art reference.²
- “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference.’”³
- Black only generically describes “compiling data relating to user traffic on the Internet,”⁴ and further Black compiles this data at Black’s “Internet Partner” which is not the same network element as “an access point.” The examiner, in the advisory action, has clarified an incorrect reading of the independent claims: “In phrase b/., Internet Partner 504 (read on ‘access point’) provides links and accesses to services and applications and receives payment (e.g., fees) from such provided links”⁵ (emphasis added). Respectfully, Black’s Internet Partner cannot be construed to be the same as the applicants’ access point. Black’s “compiling data” at the “Internet Partner” is not the same as and does not disclose “collecting statistical data for a plurality of user terminals at an access point of a network” (emphasis added) as recited in independent claims 1 and 90 (with a similar limitation in independent claim 77).
- Black describes “Telecom Revenue” that flows from a “Wireless Carrier” to an “Internet Partner”, “Internet Revenue” that flows from the Internet Partner to the Wireless Carrier,

¹ MPEP §706.07(e), Withdrawal of Final Rejection, General, ¶2.

² MPEP §2131, Anticipation - Application of 35 U.S.C. 102(a), (b), and (e)

³ MPEP §2112, Requirements of Rejection Based on Inherency; Burden of Proof, Section IV.

⁴ Black, col. 12, ll. 66-67.

⁵ Advisory Action, page 3.

and Telecom Value that flows from a User to the Wireless Carrier (see Black's Fig. 3). Clearly, the applicants' "payment associated with an account associated with an operator of the access point" is flowing towards the access point, and hence could not be read on Black's Telecom Revenue (which flows towards the Internet Partner). But Black never discloses how either the Internet Revenue or the Telecom Value (flowing towards the Wireless Carrier) is apportioned. Accordingly, Black does not describe determining "a payment associated with an account associated with an operator of the access point" "based, at least in part, on the provided statistical data" as recited in independent claims 1 and 90 (with a similar limitation in independent claim 77).

Accordingly, Black does not teach each and every element of independent claims 1, 77, and 90. The applicants request the examiner withdraw the finality of the rejection.

Claim Rejections Under § 102

Rejections under 35 USC 102(e) are valid only if each and every element is expressly or inherently described in a single prior art reference.⁶

"The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. ... To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference.'"⁷

Thus, each element of a claim must be explicitly taught, or must be clearly and necessarily present in the reference.

First, Black does not describe the "collecting statistical data for a plurality of user terminals at an access point of a network" recited in claims 1 and 90. Claim 77 includes similar language. The examiner cites the Internet Partner's compiling of data relating to user traffic on the Internet to anticipate this element.⁸ The applicants' access point, however, clearly cannot read on Black's Internet Partner. Black teaches:

The present invention is directed to a business model and method for generating and distributing Telecom and Internet revenue between a wireless network operator and

⁶ MPEP §2131, Anticipation - Application of 35 U.S.C. 102(a), (b), and (e).

⁷ MPEP §2112, Requirements of Rejection Based on Inherency; Burden of Proof, Section IV (emphasis in original).

⁸ Black, col. 12, ll. 66-67.

an Internet Partner company. The inventive business model provides an Internet web-site for the carrier's subscribers, with the web-site being developed by the Internet Partner.⁹

Internet Partner 504 produces and operates a portal or web-site for the Subscribers 506 of Wireless Carrier 502.¹⁰

Black clearly distinguishes the Internet Partner and the Wireless Carrier. It might be reasonable to construe the applicants' access point (possibly combined with the applicants' Internet Service Provider, ISP 115) as reading, at least in part, on Black's Wireless Carrier, but it is not reasonable to construe the applicants' access point as reading on Black's Internet Partner. If anything, one might see a relationship between Black's Internet Partner and the applicants' content service provider:

A user terminal (UT) 105 communicates with a server, for example, a server 130 connected to the Internet 120 and operated by a content service provider, such as Amazon.com.¹¹

The "tracking and compiling data" in Black is at the Internet Partner, and Black further teaches that the Internet Partner "may also obtain revenue" by providing "this data to the respective Carrier."¹² Accordingly, Black's Internet Partner is a different entity than the applicants' access point, and Black does not disclose "collecting statistical data for a plurality of user terminals at an access point of a network" (emphasis added).

Second, Black does not describe how payments to an operator of an access point are determined.¹³ A payment to an operator of an access point could only read on Black's Internet Revenue or on Black's Telecom Value (see Black's Fig. 3). The Telecom Value comes from a user, and Black has no disclosure of how this value is determined or apportioned. Black seemingly only has only two examples of money flowing from Black's Internet Partner to Black's Wireless Carrier:

A portion of this web-site generated Internet Value may be provided to the wireless carrier since they have provided the customer base responsible for generating the Internet Value.¹⁴

The subscribers' use of the services and applications will in turn generate Internet Value and associated revenues in the form of advertising revenues, broker fees for links placed on the web-site, transaction fees, and other forms of revenue sharing. This revenue stream is also shared between the Carrier and the Internet Partner responsible for

⁹ Black, Abstract.

¹⁰ Black, col. 9, ll. 38-39.

¹¹ Specification as filed, page 5, ll. 13-15.

¹² Black, col. 12, l. 66 through col. 13, l. 3.

¹³ Black, col. 10, line 44 through col. 11, l. 49 discusses only payments to the Internet Partner.

¹⁴ Black, col. 4, ll. 10-13.

establishing and operating the branded web-sites (since the Carrier is responsible for attracting and retaining the customers who utilize the web-site to generate the Internet value).¹⁵

Black only discloses that this “revenue stream is also shared between the Carrier and the Internet Partner.” In particular, Black does not describe that the sharing be based on data collected by the access point. The applicants point out that Black does describe ways in which the Telecom Revenue (flowing to the Internet Partner) may be apportioned¹⁶, but that the applicants’ “payment associated with an account associated with an operator of the access point” cannot be construed to read on Black’s Telecom Revenue, which flows in the wrong direction.

Accordingly, Black does not teach each and every element of claims 1, 77, 90, and dependent claims 2-12, 19, 78-86, and 91-97.

The applicants request that the examiner withdraw the rejection of claims 1-19, 77-86, and 90-97.

Claim 11 recites that the method comprises “*providing, as at least part of the statistical data, information about data packets received at the access point from the server and forwarded by the access point to at least one wireless one of the user terminals.*” Thus, the data traffic used for collecting the statistical data includes data packets that pass through the access point from the server to the wireless user terminal. Claims 86 and 97 include similar language.

The cited section of Black refers to the Internet Partner compiling data on user traffic on the Internet. Construing the Internet Partner as the access point is inconsistent with the rest of Black, which teaches, for example, that the “inventive business model includes an Internet web-site for the carrier’s subscribers, with the web-site being developed and operated by the Internet partner.”¹⁷ See also Figure 2 of Black, in which the Internet (on which the data on user traffic is compiled) is shown as distinct and removed from Black’s mobile devices and Black’s “Airnet.” Further, the examples of data gathered in Black do not include “information about data packets” or even any mention of data packets:

The Internet Partner may also obtain revenue by tracking and compiling data relating to user traffic on the Internet (e.g., types of services or applications utilized,

¹⁵ Black, col. 12, ll. 10-18.

¹⁶ Black, col. 10, ll. 44-53, for example.

¹⁷ Black, col. 3, ll. 19-22.

amount of money spent in transactions, etc.) and provide this data to the respective Carrier for that user.¹⁸

The applicants remind the examiner that the presence of data packets at a server on the Internet is not the same as the presence of data packets at an access point. The Internet is an unreliable communications medium. (The applicants refer the examiner to the Transmission Control Protocol (TCP) and the User Datagram Protocol (UDP) used for reliable and unreliable transmissions on the Internet, for example.) In other words, a packet from a server may or may not arrive at its destination. Thus, collecting statistical data on packets at a server may include data on 100% of the packets, while collecting statistical data on packets at an access point between a user terminal and a server may include less than 100% of the packets. Compiling data on Internet traffic does not necessarily mean that statistical data is collected on data packets at an access point as described in claim 11. Accordingly, Black does not teach each and every element of claims 11, 86, and 97.

The applicants request that the examiner withdraw the rejection of claims 11, 86, and 97.

Claim Rejections Under § 103

Claim 20 recites that the method comprises “providing, as at least part of the statistical data, a count of bytes of data received at the access point from the server to the plurality of user terminals.” Thus, the statistical data that is used to determine a payment in claim 1 is, at least in part, a count of bytes of data received at the access point from the server. Claims 21-22, 87-89, and 98-100 include similar language.

First, although Zhang describes an accounting stop request packet that contains a count of bytes, there is no suggestion on what to do with the count, other than sending it to an authentication, authorization, and accounting (AAA) server.¹⁹

Second, even if there is a use suggested in Zhang for the bytes, it is not for determining a payment to an operator of an access point. The data sent to the AAA server may be used for various rate schemes for customers.²⁰ Thus, it would be used to bill a customer, not determine a payment to a customer, nor determine a payment to an operator of an access point.

¹⁸ Black, col. 12, ll. 66 through col. 13, ll. 3.

¹⁹ Zhang, ¶115.

²⁰ Zhang, ¶7.

Accordingly, even if Zhang is combined with Black, there is no suggestion to use a count of bytes in the determination of a payment to an operator of an access point. At best, Zhang adds a way for Black's Internet Partner or Carrier to bill customers. The combination of Black and Zhang does not teach or suggest each and every element of claims 20-22, 87-89, and 98-100. The applicants request that the examiner withdraw the rejection of claims 20-22, 87-89, and 98-100.

New Claims

New claim 101 includes "determining the payment associated with the account associated with the operator of the access point responsive to an amount paid for the access point." New claim 102 includes "determining the payment associated with the account associated with the operator of the access point responsive to a subsidy provided for the access point". In each of these new claims, the payment to the operator of the access point depends on purchase and/or operating parameters of the access point. Both Black and Zhang are silent on such parameters of an access point.

New claim 103 includes "determining the payment associated with the account associated with the operator of the access point responsive to a portion of subscriber payments to a content service provider" and "wherein the determining is based, at least in part, on the provided statistical data." Neither Black nor Zhang describe payments to the operator of an access point in relation to payments to a content service provided and based, at least in part, on statistical data collected at the access point.

New claim 104 includes "operating the network with an internet service provider; and determining a payment for the internet service provider responsive to the statistical data." New claim 105 includes "determining, responsive to the statistical data, a portion of the payment for the internet service provider as the payment associated with the account associated with the operator of the access point." Accordingly, the determination of the payment at the billing entity includes a determination of a payment for an internet service provider, of which the payment to the operator of the access point is a portion. Black and Zhang do not describe such a payment hierarchy.

New claim 106 includes "operating the server by a content service provider; authenticating accesses of the user terminals to the network by an authenticator; determining a

payment from the content service provider to the authenticator for the authenticating; and wherein determining the payment associated with the account associated with the operator of the access point includes determining, in response to the statistical data, a portion of the payment from the content service provider to the authenticator for the operator of the access point.” The payments from the content service provider pass through the authenticator to the operator of the access point in response to the statistical data. Black and Zhang do not describe payments passing through an authenticator to an access point.

Accordingly, the combination of Black and Zhang do not teach or suggest each and every element of claims 101-106, and these claims are allowable.

Conclusion

For the foregoing reasons, the applicants request reconsideration and allowance of the remaining pending claims. The applicants encourage the examiner to telephone the undersigned at (503) 224-2170 if it appears that an interview would be helpful in advancing the case.

Customer No. 73552

Respectfully submitted,

STOLOWITZ FORD COWGER LLP



Graciela G. Cowger
Reg. No. 42,444

STOLOWITZ FORD COWGER LLP
621 SW Morrison Street, Suite 600
Portland, OR 97205